

II. Remarks:

Claims 1-11, and 13-47 are presented in this case. Of these, claims 33-47 are new.

Of the pending claims, 1-11, 13-20, and 22-29 stand rejected under 35 U.S.C.

Section 103(a) as being unpatentably obvious over Primeaux, U.S. Pat. No. 5,962,618 ("the '618 patent"). Claims 21 and 30-32 had been previously rejected as unpatentably obvious over the combination of the '618 patent in view of Xiao et al., U.S. Pat. No. 6,153,709 (though Applicant notes that the Advisory Action of February 12, 2003, made no mention of this basis for rejection).

As to the independent claims 1,13,20, and 24, it is the examiner's particular contention, augmented by the aforementioned Advisory Action, that the '618 patent teaches all aspects of the invention as claimed, but for application of the liquid material occurring in a manner which produces a "well-defined" pattern. However, the examiner asserts that such deficiency in the Primeaux reference would have been within the knowledge of one of ordinary skill in the art in order "[t]o apply the coating [of Primeaux] where impact resistance is needed and not to areas where resistance is not needed," the examiner construing such application as being "well-defined." Advisory Action, p. 4.

Applicant continues to disagree with the rejections.

The instant invention is predicated, at least in part, upon the unexpected discovery that materials such as claimed may be used to damp vibration of a substrate, including such vibration as may otherwise be transmitted through a passenger vehicle to the interior passenger cabin thereof (*see* new claims 33-47). Even accepting, *arguendo*, the

examiner's reading of the Primeaux reference as to the composition disclosed therein, it is beyond peradventure that such new use as claimed by Applicant is itself patentable subject matter. The continuing flaw in the examiner's reasoning in this matter is his refusal to acknowledge this statutorily recognized kind of invention, and to therefore reject the claimed utility as merely inherent in the Primeaux reference. The statute, therefore, is the logical starting point for Applicant's remarks.

35 U.S.C. Section 101, which defines patentable subject matter, states that "[w]hoever invents or discovers any new and useful process...or any new and useful improvement thereof, may obtain a patent therefore...." A "process," within the meaning of Section 101, includes a "process, art or method, and...a new use of a known process, machine, composition of matter, or material." 35 U.S.C. § 100. In short, the law explicitly recognizes and admits of method patents to *new uses* for old structures, and even new uses for old methods.

Reasoning from the holdings in In re Casey, 152 USPQ 235 (CCPA 1967), and In re Otto, 136 USPQ 458 (CCPA 1963), the examiner asserts that "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish....," and that "[i]f the prior art structure is *capable* of performing the intended use, then it meets the claim." Advisory Action, p. 2 (*emphasis added*). The examiner also states that, "[i]n a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." *Id.* But the cited decisions, and thus the examiner's contentions, are inapposite to *method* claims, which fact must be eminently clear from

the statutory language quoted above. If it were the case that no method patent could be had where the prior art structure is merely *capable* of performing the intended use, as the examiner claims, then the ability to patent a "new use of a known...composition of matter" would be without meaning. As implied, this is simply not the case.

The particular decisions upon which the examiner relies cannot, and in reality do not, support the examiner's assertions. At issue in In re Casey was the patentability of *article* claims containing *functional* language, *not* method claims directed to a new use of the article. 152 USPQ at 237. For this reason, the court agreed that the functional limitations in an apparatus claim "are method steps and cannot confer patentability on an apparatus claim." *Id.* at 238. Similarly, the matter at hand in In re Otto was the patentability of *article* claims, and a method of *making* such an article, as opposed to claims to a method of using the article. 136 USPQ 458. These decisions, and the principles for which they stand, are wholly inapplicable to method claims directed to the use of a composition.

Perhaps recognizing the shortcomings of the above position, the examiner endeavors to discount Applicant's claimed method of use for the recited composition by asserting that:

"[T]he limitations of the claims are clearly drawn to a method of coating. The only 'use' to speak of is in the preamble of the claims, where it is stated 'a method for damping vibration of a substrate comprising the steps of.' The process steps in the limitations are not steps for damping vibration; they are steps for putting a coating on a substrate where the coating has damping properties. Therefore, the recitation of 'use' has not been given patentable weight because the recitation only occurs in the preamble." Advisory Action, p. 3.

However, the examiner's arguments deny the clear language of the claims, which

positively recite attenuating vibration of a substrate, including a body component for a passenger vehicle. Thus, while the steps may well recite the act of putting the material on a substrate, the application (i.e., attenuating vibration) *cannot* be discounted.

Finally, the examiner again asserts in the recent Advisory Action that, because the coating of Primeaux is the same as claimed by Applicant (which assertion is not conceded), "the damping properties must be inherent." *Id.*

Applicant recognizes that there are cases where even an allegedly new use is not patentable. In In re May, for instance, claims directed to a method of effecting non-addictive analgesia were held to be anticipated by prior art which taught the same compounds for effecting analgesia, but which was admittedly silent as to the non-addictive benefit. 197 USPQ 601 (CCPA 1978). However, In re May dealt *not* with a *new use* for the compound, but rather the same use with a newly appreciated benefit.

In contrast, the court in In re Shetty, 195 USPQ 753 (CCPA 1977), held patentable claims to a method of appetite suppression by administering adamantane compounds, in spite of prior art teaching analagous compounds, including as administered to animals as an anti-viral. In that case, the use (appetite suppression) was truly new, notwithstanding the fact that prior art use of analogous compositions as an anti-viral undoubtedly generated some unknown appetite suppression.

Even accepting, for argument's sake, the examiner's assertion that the instantly-claimed composition is identical to that disclosed in Primeaux, the method claims at issue are clearly directed to a *new use*, rather than simply a side-effect of an old use. Specifically, Primeaux is directed to a *durable lining for railway freight cars*. Applicant,

on the other hand, has surprisingly discovered that the instantly-claimed compositions advantageously function to attenuate vibration of a substrate, and so may be employed to attenuate the transmission of vibrations into the interior passenger cabin of a passenger vehicle. These utilities are decidedly *not* the same. As such, Applicant's claimed invention is, in relation to the utility of the prior art, more analogous to the precedent established in In re Shetty than that set forth in In re May.

Because the use of Applicant's invention is truly new, it is improper for the examiner to rely on the asserted inherency of result in making the obviousness rejection. As the court stated in In re Shetty, in the face of the Patent Office's urging that appetite suppression was an inherent result, the court stated that "[i]nherency is immaterial if one of ordinary skill would not recognize or appreciate the inherent result." 195 USPQ 753 (CCPA 1977); *see also* In re Spormann, 150 USPQ 449 (CCPA 1966). Here, the suggestion that one of ordinary skill would have, at the time of Applicant's invention, appreciated the vibration attenuating utility of the Primeaux *lining* is untenable in the face of the fact that the Primeaux lining is applied in a passengerless environment (i.e., railway freight cars).

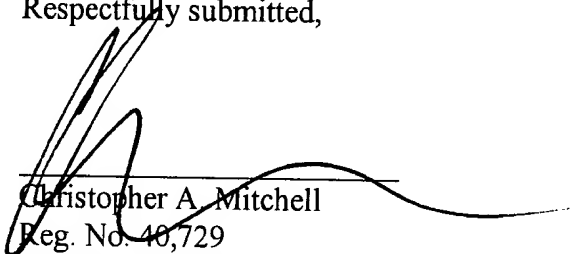
In view of the above arguments, Applicant respectfully submits that the rejections of the remaining dependent claims, including claims 21 and 30-32 over the combination of Primeaux in view of Xiao et al. (to the extent they are maintained), are rendered moot. This fact notwithstanding, Applicant notes that the art of record, taken alone or in any permissible combination, fails to either anticipate or render obvious the invention of these claims. Should the examiner maintain the rejections to the claims, Applicant reserves the

right to place the claims in allowable form, argue the patentability thereof, and/or appeal such rejection.

III. Conclusion

In view of the foregoing, Applicant submits that the claims are in condition for immediate allowance. Of course, the examiner is invited to contact Applicant's undersigned counsel at (734) 662-0270 if he should have any questions respecting this paper, or if a telephonic interview might otherwise expedite the prosecution of this case.

Respectfully submitted,



Christopher A. Mitchell
Reg. No. 40,729
YOUNG & BASILE, P.C.
2001 Commonwealth Blvd.
Suite 301
Ann Arbor, Michigan 48105
(734) 662-0270

DATED: February 20, 2003